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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,530	01/07/2002	Yi-Feng Wang	CYC-041	9791
21323	7590	12/19/2003	EXAMINER	
TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110			BROWN, JENNINE M	
		ART UNIT	PAPER NUMBER	
		1755		

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/040,530	Applicant(s) WANG, YI-FENG
	Examiner Jennine M. Brown	Art Unit 1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) 1-31 and 38-40 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 32-37 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4,5,7 6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 1-31 and 38-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9 submitted 10/01/2003. No argumentation for the traversal has been given at this time.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claims Analysis***

It is unclear whether the entire polymer structure is to have 25 or more carbon atoms, whether the structural repeat of the macrocyclic oligoester is to have 25 or more carbon atoms, whether the alkylene group is to have 25 or more carbon atoms or the divalent aromatic or acyclic group is to have 25 or more carbon atoms. When applicants refer to "a polymerization catalyst comprising polymeric group comprising 25 or more carbon atoms" in pending claims 32-37, the examiner assumes, based on the specification, that this refers to the entire polymerized structure which can be any polyalkylene group such as polyethylene, polypropylene, polyisopropylene,

polybutylene, polyisobutylene and copolyalkylenes as stated at the bottom of page 9 of the specification and are made up of commercially available alkynes having 2-8 carbon atoms as stated on page 3 of the specification. The specification does not teach any limitation on the length, the density or other property of the polymeric group. Therefore for examination purposes, the examiner assumes the alkynes will have 2-8 carbon atoms, which make up the polymerized structure, which will have a minimum of 25 carbon atoms.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Winckler, et al. (US 6420074 B2 or US 6639009 B2 or US 6369157 B1).

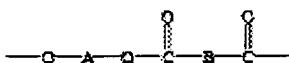
The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

1. US 6420074

Winckler, et al. have previously disclosed a method for polymerizing a macrocyclic polyester with the oligomer structural repeat given below:



"where A is an alkylene, or a cycloalkylene or a mono- or polyoxyalkylene group; and B is a divalent aromatic or alicyclic group. (col. 5, l. 31-42)" The oligomeric material is made from a macrocyclic polyester (col. 5, l. 23-30) mixed with a polymerization catalyst (col. 6, l. 30-37) and polymerized by heating the macrocyclic polyester oligomer to an elevated temperature (130 degrees C to about 250 degrees C). (col. 12, l. 41-52) The macrocyclic polyester oligomer melted with instant heating where the molten macrocyclic polyester oligomer is rapidly cooled are thermosetting resins. (col. 17, l. 35-58) Linear polyesters are used in techniques such as extrusion, compression molding, and injection molding. (col. 1, l. 30-32)"

2. US 6639009

Winckler, et al. have previously disclosed a method for polymerizing a macrocyclic polyester with the oligomer structural repeat given below:



"where A is an alkylene, or a cycloalkylene or a mono- or polyoxyalkylene group; and B is a divalent aromatic or alicyclic group. (col. 5, l. 34-45)" The oligomeric material is made from a macrocyclic polyester (col. 5, l. 26-33) mixed with a polymerization catalyst (col. 6, l. 34-41) and polymerized by heating the macrocyclic polyester oligomer to an elevated temperature (130 degrees C to about 250 degrees C). (col. 12, l. 64 – col. 13, l. 7) The macrocyclic polyester oligomer melted with instant heating where the molten macrocyclic polyester oligomer is rapidly cooled are thermosetting resins. (col. 17, l. 63 – col. 18, l. 19) Linear polyesters are used in techniques such as extrusion, compression molding, and injection molding. (col. 1, l. 35-37)"

3. US 6369157

Winckler, et al. have previously disclosed a method for polymerizing a macrocyclic polyester with the oligomer structural repeat given below:



"where A is an alkylene, or a cycloalkylene or a mono- or polyoxyalkylene group; and B is a divalent aromatic or alicyclic group. (col. 5, l. 1-8)" The oligomeric material is made from a macrocyclic polyester (col. 4, l. 57-63) mixed with a polymerization catalyst (col. 5, l. 63 – col. 6, l. 3) and polymerized by heating the macrocyclic polyester oligomer to an elevated temperature (130 degrees C to about 250 degrees C). (col. 11, l. 65 – col. 12, l. 9) The macrocyclic polyester oligomer melted with instant heating where the molten macrocyclic polyester oligomer is rapidly cooled are thermosetting resins. (col.

16, l. 60 – col. 17, l. 16) Linear polyesters are used in techniques such as extrusion, compression molding, and injection molding. (col. 1, l. 29-31)"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (703) 305-0435. The examiner can normally be reached on M-F 8:00 AM - 6:00 PM; first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

After the move to the new USPTO Headquarters in Alexandria, VA, tentatively scheduled for the week of December 22, 2003, the examiner's new phone number will be (571) 272-1364 and Mr. Bell's new phone number will be (571) 272-1362.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jmb

*Elizabeth Woods*  
ELIZABETH WOODS  
PRIMARY EXAMINER